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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,337	09/11/2003	Leslie Mark Ernest	AUS920030409US1	5985
7590 08/14/2008				
Darcell Walker Suite 250 9301 Southwest Freeway Houston, TX 77074			EXAMINER BATES, KEVIN T	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 08/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/660,337

**Applicant(s)**

ERNEST ET AL.

**Examiner**

KEVIN BATES

**Art Unit**

2153

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-8, 10, and 12-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-8, 10, and 12-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

This Office Action is in response to a communication received on June 9, 2008.

Claims 1, 8, 15, and 21 have been amended.

Claims 5-6, 9, and 11 have been cancelled.

Claims 1-4, 7-8, 10, and 12-27 are pending in this application.

***Examiner's Note***

The Examiner would like to note that the present application has been **reassigned to a new Examiner**. Furthermore, the examiner believes that a **phone interview might be helpful** in clearing up the issues of this application and help accelerate the prosecution.

***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 15 and 21 have been amended to include "a computer readable storage medium". There is no antecedent basis for storage mediums in the specification, only computer readable media found page 11-12 of the specification. The examiner believes that an amendment to the specification that comprises in line 30 of the specification "of computer readable media include storage media such as EPROM, ROM, tape, paper, floppy," would not constitute new matter

added to the specification and would avoid any non-statutory subject matter in regards to the non-patentable subject matter of transmission media.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 7-8, 10, and 12-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding claim 1:**

The claim comprises each of “an attachment document, the attachment, and the attachment docket, it is not clear from the claim whether each of these items are the same thing, or if they are intended to be different entities.

The claim comprises the limitation “receiving an electronic mail message at a destination location” in line 3, then goes on to recite “the electronic mail message received at the sender location” in line 11. It is not clear from what is being implied by having the mail message received at the destination and at the sender.

The claim comprises the limitation “the original document” there is no antecedent basis for the original document.

The claim recites both “*when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message, deleting the attachment document from the electronic mail message received at the sender*”

*location of the electronic mail message originated at the destination location of the electronic message*" and *"deleting the attachment document when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message updating the received message to reflect the deleted attachment."* Those limitation appear to be the same concept only worded differently, it is unclear if the steps are performed twice or if they perform a slightly different function.

The claim recites *"creating a link to the original document located at the destination location of the electronic message."* It is not clear from this limitation what the original document is, or if the original document what based on what the sender was attaching to the email why that document is located at the destination, not at the sender.

The claim recites "determining whether there is an attachment document associated with the received electronic mail message; when the determination is that there is an attachment document, determining an the origin of the an attachment to the electronic message, by determining whether the attachment was created at the location of the sender of the electronic message." The use of commas in this limitation suggests that the "by determining..." limitation is modifying the determination of whether there is an attachment, not the step of determining the origin of the attachment document.

**Regarding claim 2:**

The claim recites the idea that the destination location is the sender location. It is unclear how or why the sender location is also the receiving location unless all the mail messages are only being sent to themselves.

**Regarding claim 3:**

The claim appears to need some punctuation to convey the idea that the step of determining if there is an attachment occurs before the origin determination.

The limitation of determining if the email contains an attachment has been amended into the independent claim, there appears to be a lack of antecedent basis now in claim 3.

**Regarding claim 7:**

There is a lack of antecedent basis for "the recipient."

The claim recites the limitation "the step of determining whether the recipient of an electronic message desires to save the electronic message," the idea of the computer determining a user's desires is very ambiguous, there seems to be a separation between an action that the user of a computer indicates through a GUI prompt for example and what a user "desires." The word "desires" also appears in claims 8, 14, 21, and 27, and suffers from the same ambiguity in each claim.

**Regarding claim 8:**

The claim recites the idea that the attachment document was received in an email message, but the attachment was locally created at the destination location. It is unclear from the claim how the attachment can be both received and also locally created.

Claim 8 contains most of the same issues noted in the 112 rejection to claims 1 and 7.

**Regarding claims 10, 12, and 14:**

The claims recite the limitation "said origin determination," but the origin determination step has been cancelled from claim 8.

**Regarding claim 13:**

The claim recites the limitation "the modified attachment." There is no antecedent basis for this limitation; no limitations indicate an attachment actually gets modified.

**Regarding claim 18:**

The limitation added in claim 18 appears to be already present in claim 15, thus duplicate.

Claims 15-27 further comprise the same clarity issues as noted in claims 1-4, 7-8, 10, and 12-14 and appropriate action is required. For the purpose of further prosecution, the examiner has attempted to provide an art rejection based on a reasonable interpretation of the claims despite their numerous ambiguities.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 1-4, 7 and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Malik (7003551).**

**Regarding claims 1 and 15,** Malik teaches a method for managing attachments documents to electronic mail messages comprising the steps of:

receiving an electronic mail message at a destination location (Col. 4, lines 14 – 28);

determining whether there is an attachment document associated with the received electronic mail message (Col. 4, lines 14 – 28); when the determination is that there is an attachment document, determining an origin of the an attachment to the electronic message, by determining whether the attachment was created at the location of the sender of the electronic message (Col. 5, lines 38 – 42);

when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message, deleting the attachment document from the electronic mail message received at the sender location of the electronic mail message originated at the destination location of the electronic message (Col. 5, lines 38 – 53);

creating a link to the original document located at the destination location of the electronic message (Col. 5, lines 38 – 53);

deleting the attachment document when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message updating the received message to reflect the deleted attachment (Col. 5, lines 38 – 53); and



determining if there are additional attachment documents in the received electronic mail message (Col. 4, lines 1 – 13).

**Regarding claim 2**, Malik teaches the method as described in claim 1 wherein the destination location of the electronic message is the location of the sender of the electronic message (Col. 4, lines 14 – 28).

**Regarding claims 3 and 16**, Malik teaches the method as described in claims 1 and 15 further comprising before said origin determination step the step of determining whether the received electronic message has an attachment (Col. 5, lines 38 – 42).

**Regarding claims 4 and 17**, Malik teaches the method as described in claims 1 and 15 further comprising after said the attachment deleting step, the step of saving the electronic message (Col. 5, lines 38 – 53).

**Regarding claims 7 and 20**, Malik teaches the method as described in claims 1 and 15 further comprising before said attachment origin determination step, the step of determining whether the recipient of an electronic message desires to save the electronic message (Col. 5, lines 38 – 53).

**Regarding claim 18**, Malik teaches the computer program product as described in claim 15 wherein said attachment origin determination instructions further comprise instructions for determining whether the attachment was created at the location of the sender of the electronic message (Col. 5, lines 38 – 53).

**Regarding claim 19**, Malik teaches the computer program product as described in claim 15 further comprising before said link creation instructions, instructions for updating the received message to reflect the deleted attachment (Col. 5, lines 38 – 53).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 8, 10, 12-14 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik in view of Dunn (2004/0034688).**

**Regarding claims 8 and 21**, Malik teaches a method for managing the storage of attachments documents to electronic mail messages comprising the steps of;

receiving an electronic mail message at a destination location (Col. 4, lines 14 – 28);

determining whether a received electronic mail message has an attachment document (Col. 4, lines 14 – 28;

when the determination is that the received electronic mail message does have the attachment document, determining whether the attachment was locally created (Col. 5, lines 38 – 42);

deleting the attachment document from the message (Col. 5, lines 38 – 53);

creating a link to the original document located at the destination location of the electronic message (Col. 5, lines 38 – 53); and

storing the receive electronic mail message without the attachment document (Col. 5, lines 38 – 53).

Malik does not explicitly indicate when the determination is that the attachment document was locally created, determining whether the electronic mail recipient desires to modify the attachment document that was locally created at the destination location of the electronic message; and

when the determination is that the user does not want to modify the attachment document.

Dunn teaches when a user wants to modify a copy of an attachment, obtaining a local copy of that attachment (See abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Dunn's teaching of obtaining the copy of an attachment when the user wishes to get access to modify an attached file in Malik's system to allow the recipient full access to received file attachments, while preventing too many other copies of the attachment to exist.

**Regarding claims 10 and 23**, Malik teaches the method as described in claims 8 and 21 further comprising before said origin determination step the step of determining whether the received electronic message has an attachment (Col. 5, lines 38 – 53).

**Regarding claims 12 and 25**, Malik teaches the method as described in claims 8 and 21 wherein said attachment origin determination step further comprises determining whether the attachment was created at the location of the sender of the electronic message (Col. 5, lines 38 – 53).

**Regarding claims 13 and 26**, Malik teaches the method as described in claims 8 and 21 further comprising before said link creation step, the step of updating the received message to reflect the modified attachment (Col. 5, lines 38 – 53).

**Regarding claims 14 and 27**, Malik teaches the method as described in claims 8 and 21 further comprising before said attachment origin determination step, the step of determining whether the recipient of an electronic message desires to save the electronic message (Col. 5, lines 38 – 53).

**Regarding claim 22**, Malik teaches the computer program product as described in claim 21 further comprising after said modification determination instructions, instructions for modifying the attachment (Col. 5, lines 38 – 53).

**Regarding claim 24**, Malik teaches the computer program product as described in claim 22 further comprising after said modification determination instructions, instructions for deleting the attachment when there is a determination that the recipient does not want to modify the attachment (Col. 5, lines 38 – 53).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4, 7-8, 10, and 12-27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN BATES whose telephone number is (571)272-3980. The examiner can normally be reached on 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin Bates/  
Primary Examiner, Art Unit 2153